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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,282	11/26/2003	Thomas Wien	11286-01250	1147

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Douglas N. Larson
Squire, Sanders & Dempsey, L.L.P.
14th Floor
801 S. Figueroa Street
Los Angeles, CA 90017

EXAMINER

CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/724,282

Applicant(s)

WIEN ET AL.

Examiner

Sing P. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 231-271, 273-294, 296-301, 303-344, 351-356, 358-362 and 366-389 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 250-271, 273-290, 296-301, 315-336, 338-344, 351-356, 358-362, 366-371, 373-384 and 386 is/are allowed.
- 6) ☒ Claim(s) 231-244, 246-249, 291-294, 303-305, 309-312 and 387-389 is/are rejected.
- 7) ☒ Claim(s) 306-308, 313, 314, 337, 372 and 385 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 388 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recited "non-rotatable," which is a negative limitation and require the negative limitation to be recited in the original specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 372 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 372 is depended on claim 365, which has been canceled. For the purpose of examination, "claim 366" will be assumed.

Claim Objections

5. Claim 337 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

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required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim 336 has the limitation of claim 337.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 387 and 389 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiraki (U.S. 3,680,872).

Hiraki discloses an apparatus with an embedded adapter for a turntable. The apparatus includes a rotating shaft, a turntable, i.e. a support surface, a recessed portion with an adapter housing with outer peripheral wall, a bottom wall, and an annular inner wall contacting the rotating shaft. (Col 2, lines 20-36) The adapter includes a cylindrical body (6), which can be raised upward when a plate (7) is depressed downwardly and the cylindrical body (6) can then be pushed down flush with upper surface of the turntable with fingers, which is manually positionable by a user and along a vertical axis. These structures are considered capable of centering labels with different aperture and a disk, which satisfied the "intend used" of claims for supporting a label and guiding a disk onto the adhesive of the labels.

8. Claims 387-389 are rejected under 35 U.S.C. 102(b) as being anticipated by Hummell et al (U.S. 5,951,819).

Hummell et al discloses an apparatus for applying a label. The apparatus includes base with a label support surface (Col 2, lines 25-29), a plunger element with a lip element (Col 2, lines 58-64), manually movable up and down relative to the base (Col 2, lines 64-67) along a vertical axis with a fixed and non-rotatable label support surface, and the plunger element can be placed in the compressed position by pushing the plunger downward to the fully compressed position and then twisting or rotating the plunger element to lock onto the catch element (41) (Col 3, lines 63-67). Therefore, the examiner is taking the position the apparatus is capable of centering a label with small central open as well and a label with a larger central open, with the plunger in the up position the larger diameter portion can be used to center labels with a larger centering hole and when the plunger is in the down position, the smaller portion of the plunger can be used to center labels with smaller centering hole.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 231-244, 246-249, 291-294, 303-305, and 309-312 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolosko et al (U.S. 4,000,906) in view of Miyoshi (U.S. 3,848,875).

Regarding claims 231-236, 238, 240, 241, 246-249, 291-294, 303-305, 310, and 312, Kolosko et al discloses a two speed automatic phonograph. The phonograph includes a turntable driven by a two-speed drive, a centering pin for centering a record with a small aperture, and a plurality of upward directed guides to automatically center record with larger aperture. (Col 3, line 47 to Col 4, line 14 and Figure 3) Furthermore, the guides are partially depressed with an extremely low force tangentially about the pivot to cause the arms or guides to retract (Col 4, lines 23-40). These structures are considered capable of centering labels with different aperture and a disk, which satisfied the intended use of claims for supporting a label and guiding a disk onto the adhesive of the labels. Kolosko et al is silent as to the centering pin includes article support surface. However, providing an article support surface for a centering pin is well known and conventional as shown for example by Miyoshi. Miyoshi discloses a centering spindle with an article or disk support. The spindle includes an inner shaft and primary support (Col 14, lines 14-28), when the inner shaft is pulled downward, the primary support is gradually withdrawn within a spindle housing to release the disk or article to be pressed down onto the turntable (Col 15, lines 49-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the centering pin with article support as disclosed by

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Miyoshi in the apparatus of Kolosko et al to provide a support with automatic individual stacking of the article or disk onto the turntable. (See Miyoshi, Col 1, lines 6-14)

Regarding claim 237, Kolosko et al discloses the guides radially outward from the post or centering pin. (Figure 3)

Regarding claims 239 and 309, Kolosko et al as modified by Miyoshi is silent as to the diameter of the small hole is 0.656 or 0.604 inch and the large hole is 1.625 inch. However, one of ordinary skill in the art would appreciate providing the proper sized structure for the holes and would be logical to size the structure to fit the intended purpose of the structures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to logically sized or position the centering structures to fit the aperture such as 0.656 inch, 0.604 inch, or 1.625 inch in the apparatus of Kolosko et al as modified by Miyoshi to allow the structure to properly centering the articles.

Regarding claims 242-244 and 311, the apparatus of Kolosko et al is considered to be capable of centering article such as CD, optical disk, and DVD.

Allowable Subject Matter

11. Claims 250-271, 273-290, 296-301, 315-336, 338-344, 351-356, 358-362, 366-371, 373-384, and 386 are allowed.

12. Claims 306-308, 313, 314, and 385 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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13. Claim 372 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed December 18, 2006 have been fully considered but they are not persuasive.

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at least one locator member and a lift post operatively connected to the at least one locator member) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the limitation is recited in a dependent claim 385.

16. In response to applicant's argument that claims 231 and 248 recite "a first label or alternatively a second label on the label support surface," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

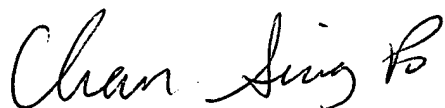
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SPC



CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER

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